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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,300	11/28/2000	Nicholas M. Vander Wal	076507-0305	4791
26371	7590	01/22/2004	EXAMINER	
FOLEY & LARDNER 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			POE, MICHAEL I	
			ART UNIT	PAPER NUMBER
			1732	
DATE MAILED: 01/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/724,300

Applicant(s)

WAL ET AL. 

Examiner

Michael I Poe

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 18-28 and 48-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 18-28, 52-56 and 58 is/are rejected.
- 7) ☒ Claim(s) 48-51 and 57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Amendments***

1. Applicant's amendment B filed on May 23, 2002 has been entered. Based upon the entry of this amendment, no existing claims have been amended, existing claims 15-17 and 29-47 have been canceled, and new claims 48-58 have been added. Claims 1-14, 18-28 and 48-58 are currently pending.

### ***Information Disclosure Statement***

2. The information disclosure statement filed on May 18, 2001 (Paper #5) includes many references that have been listed in duplicate. For each of the references that have been listed in duplicate, one occurrence has been indicated as being considered and a second occurrence has been indicated as not being considered. For example, U.S. Patent No. 5,111,630 to Munsey et al. is listed both on line B4 of page 2 and line C12 of page 3; and it has been indicated as being considered on line C12 while having been indicated as not being considered on line B4. As such, all of the references cited on the information disclosure statement have actually been considered even though some are listed as not being considered.

### ***Election/Restrictions***

3. Applicant's election without traverse of Group I, claims 1-14 and 18-28 in Paper No. 7 is acknowledged.

4. Claims 15-17 and 29-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7. It is noted that the non-elected claims were canceled in Applicant's amendment B filed on May 23, 2002.

5. Applicant's election with traverse of the species of Group I illustrated in Figures 16A/16B in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the species of Figures 16A/16B, 17, 18 and 20A/20B are not patentably distinct and are illustrative of a common invention. The applicant's traversal

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has been found persuasive by the examiner; therefore, the species restriction with regard to Figures 16A/16B, 17, 18 and 20A/20B has been withdrawn herein. However, the species restriction between the species illustrated in Figures 4A/4B and 16A/16B remains in effect since it has not been traversed by the applicant in their response. However, claims 7-9, 11-13, 20-28, 48-51, 56 and 57 are generic and allowable over the prior art of record although they currently stand rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph or objected to as being dependent on rejected base claims. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 6-14 and 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 10 include the recitation "providing a rack to hold the tiles during the manufacturing process". This recitation is confusing because it would be unclear to one reading the claims what the rack is holding and when it is holding it. Specifically, the applicant uses the term "tiles" to refer to the final product of the manufacturing process, and therefore the rack would not be able to hold the "tiles" until after the completion of the manufacturing process. Based upon the applicant's original disclosure, it

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appears that the rack is intended to hold the shells during the manufacturing process rather than the tiles and to hold the tiles after the completion of the manufacturing process (e.g., during shipping, cleaning, drying, etc.). For the purpose of this Office action, the examiner has assumed that the applicant intended to claim providing a rack to hold a plurality of outer shells during the manufacturing process and a plurality of tiles after the manufacturing process.

8. Claims 20-28 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the steps showing how the plurality of racks is related to the manufacturing operations (e.g., filling, washing, drying, inspecting, delivering, etc.). For the purpose of this Office action, the examiner has assumed that the manufactured shells are loaded on the plurality of racks at the remote facility and that the plurality of racks are employed through all of the manufacturing operations.

#### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by French Patent Publication No. FR-2416315-A or U.S. Patent No. 3,603,052 (Novoa).

#### **Claims 1 and 5**

See specifically the Derwent Abstract of FR-2416315-A. See specifically column 1, lines 52-55; column 2, lines 38-64; and column 3, lines 27-58 of Novoa.

#### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2-4, 6, 10, 14, 18, 19, 52-55 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,229,051 (Martin) in view of either French Patent Publication No. FR-2416315-A or U.S. Patent No. 3,603,052 (Novoa).

**Claims 2-4, 6, 10, 14, 18, 19, 52-55 and 58**

Martin teaches a method for making sleeve encased concrete posts (comprising an outer shell and an inner core material) including providing (constructing or manufacturing) a plurality of sleeves (shells or outer shells); positioning (loading or stacking or holding) a plurality of sleeves in a filling rack wherein each sleeve 18 is supported on a vibrator mechanism 22; pouring (filling) a concrete slurry 24 (cementitious mixture core material or fill material or core material or filling material) into each sleeve 18 while the sleeve is supported in the filling rack; allowing the concrete to dry long enough to set; and removing the thus formed concrete posts from the filling rack (column 2, lines 13-56). Note that the action of moving the filling rack between sleeve loading location, the filling location and the removing location in the process of Martin would constitute a step of moving or transporting the rack through a plurality of stations whereby one or more manufacturing operations may be performed on the outer shells. Note further that, as illustrated in the Figures, Martin teaches that the sleeves are positioned in the filling rack in a vertical orientation. Note further that the vibrator mechanism would serve to protect the lower edge of the sleeves in the filling rack.

Although Martin teaches the basic claimed process, Martin does not specifically teach that the molding process can be used to make structural tiles or panels, transporting the sleeves to a remote location associated with a job site or a local facility while on the rack, and forming the sleeve encased articles at a remote location or a local facility such as a construction site or local installation site.

However, FR-2416315-A and Novoa teach methods for forming modular cladding panels and construction elements (tiles or panels comprising an outer shell and an inner core material), respectively, including providing (constructing or manufacturing at manufacturing facility or first location) a plurality of

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shells; transporting (delivering) the shells to the assembly site (a remote location or local facility or construction site or local installation site or second location); and filling the shells at the assembly site with a cement mixture core material (see Derwent Abstract of FR-2416315-A and column 1, lines 52-55; column 2, lines 38-64; and column 3, lines 27-58 of Novoa). Note that the claims as currently written do not require the installation location to be different from the second or remote location. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made and one of ordinary skill would have been motivated to use the molding process of Martin that includes the use of a filling rack to construct structural tiles or panels on site at a structure assembly site as taught by FR-2416315-A or Novoa to provide an economical method of simultaneously forming a plurality of structural tiles or panels on site to thereby allow more rapid assembly of the structure while reducing the cost of shipping the structural tiles or panels to the structure assembly site. Note that the recitation "for use in a raised floor system" is solely a recitation of intended use, and therefore does not carry any patentable weight in the instant claims. As such, any type of structural tile or panel (e.g., wall, ceiling, floor, etc.) would be readable on the instant claims.

With regard to the aspect of cleaning the molded tiles or panels (e.g., washing and drying) and inspecting the molded tiles or panels, the examiner takes official notice that it was generally well known in the art at the time the invention was made to clean molded products via washing and drying and to inspect molded products after molding. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made and one of ordinary skill would have been motivated to clean (e.g., wash and dry) and inspect the molded structural tiles or panels produced by the process of Martin in view of FR-2416315-A and Novoa as was generally well known in the art to assure the quality and structural integrity of the molded structural panels or tiles to thereby assure that the assembled structure was free of defects.

***Allowable Subject Matter***

13. Claims 7-9, 11-13, 20-28 and 56 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. Claims 48-51 and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter:

(1) With regard to claims 7-9, 11-13 and 56, the prior art of record does not teach or suggest the claimed processes of manufacturing panels or tiles, as a whole, especially including cleaning (i.e., washing and/or drying) the panels or tiles while positioned a rack that holds those panels or tiles. Although the process of Martin in view of either FR-2416315-A or Novoa would teach the use of a rack for manufacturing a plurality of structural tiles or panels simultaneously, the structure of the rack in the process of Martin in view of either FR-2416315-A or Novoa would prevent further treatment (e.g., cleaning) of the structural tiles on the rack. Therefore, the combination of Martin in view of either FR-2416315-A or Novoa teaches away from this aspect of the applicant's claimed invention.

(2) With regard to claims 20-28, the prior art of record does not teach or suggest the claimed processes of manufacturing panels or tiles, as a whole, especially including loading the manufactured shells into a plurality of racks at a remote facility, delivering the shells on the plurality of racks to a local facility, manufacturing (e.g., filling, washing, drying, and inspecting) the panels on the plurality of racks at the local facility, and delivering the panels to a local installation site on the plurality of racks.

(3) With regard to claims 48-50 and 57, the prior art of record does not teach or suggest the claimed processes of manufacturing panels or tiles, as a whole, especially including providing a racking system having the structural element defined in claims 48-50 and 57. Although Martin in view of either FR-2416315-A or Novoa would teach a racking system for molding structural tiles or panels, the racking system taught by Martin in view of either FR-2416315-A or Novoa is structurally distinct from the claimed racking system, and therefore it would be structurally impossible to modify the racking system of Martin in



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view of either FR-2416315-A or Novoa to come up with the racking system as defined in claims 48-50 and 57.

(4) With regard to claim 51, the prior art of record does not teach or suggest the claimed processes of manufacturing panels or tiles, as a whole, especially including providing a plurality of bosses on a bottom plate of the outer shells wherein, when stacking the shells, the bosses on the bottom plate of one of the tiles contacts the top plate of the outer shell of an adjacent tile to provide a clearance between the tiles.

### **Conclusion**

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 3,739,050 (Koncz et al.), U.S. Patent No. 4,067,941 (Gaudelli et al.), U.S. Patent No. 4,234,534 (Ito et al.), U.S. Patent No. 4,423,574 (Pierre), U.S. Patent No. 4,729,859 (Munsey et al.), U.S. Patent No. 4,856,256 (Tokuzo), U.S. Patent No. 5,096,648 (Johnson et al.), U.S. Patent No. 5,115,621 (Kobayashi), U.S. Patent No. 5,853,512 (McKinney), U.S. Patent No. 6,638,393 B2 (Lehan), Japanese Patent Publication No. 05-133079 A (Hidenori), and Japanese Patent Publication No. 06-317005 A (Minoru et al.) have been cited of interest to show the state of the art at the time the invention was made.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael I Poe whose telephone number is (571) 272-1207. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael Poe/mip



**MICHAEL COLAIANNI**  
**PRIMARY EXAMINER**